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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/678,330

Applicant(s)
Kimura et al.

Examiner
Venkataraman Balasubramanian

Group Art Unit
1624



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-9 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____.
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-9 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 9/30/1999. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Claims 1-9 recite the term "derivative" which is indefinite as it implies more than what is being positively recited. Note any organic/ inorganic group may be appended to formula I to qualify as derivative thereof. Hence the structural make-up of the resultant product remains unknown. Its replacement with "compound" is suggested.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buell US 3,309,363 in view of Deguchi et al. US 5,395,742.

Buell teaches 4,4'-Bis 1,3,5-triazinylamino)stilbene-2,2'-disulfonic acid bearing dihydroxypropylamino groups for use as optical brightener. See formula shown on col.1 and example 1 on col. 3 for making the compound. Note the side chain, dihydroxypropylamino, is same as claimed herein.

Buell differs from the instant claims in not teaching or suggesting sulfoethylamine substituent on the triazine ring.

Deguchi et al. teaches several diaminostilbene compounds for photographic imaging. See formula I on col. 2 and note the definition of L^1 and L^2 . Note on col. 3 lines 10-16, Deguchi et al. teaches four or more substituents on L^1 and L^2 . Also note L^1 and L^2 can be $N R^2 R^3$ which permits alkylamine with hydroxyl groups and sulfo groups as required herein. See col. 4-5 for various preferred embodiments and tables on col. 6-7 and 11 for compounds made.

Starting materials and the final products taught by these two references are analogous in that they cyanuric halide, substituted amines and 2,2-diaminostilbene sulfonic acid. Thus one having ordinary

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skill in the art at the time of the invention was made would have been motivated to combine both the primary and secondary references and employ the process taught by these prior art to the starting materials and reactants including those with aminoalkyl with two or more hydroxyl and sulfoalkylamino and expect to obtain the desired product because he would have expected the analogous starting materials and reactants react similarly. It has been held that application of an old process to an analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill. Note In re Kerkhoven 205 USPQ 1069.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crounse et al. US 3,193,548 in view of Deguchi et al. US 5,395,742.

Crounse et al. several triazinyl stilbene compounds with hydroxyalkoxyalkylamino side chain in the triazine ring as optical brightening agents. See formula I on col. 1 and note the definition of Y¹ and Y². Note the teachings include equivalency of hydroxyalkylamino with hydroxyalkoxyalkylamino. See line 44 for a formula which is a side chain generically claimed herein. See col. 2-4 for preferred embodiments and col. 5-14 for examples of compounds made..

Crounse et al. differ from the instant claims in not teaching sulfoalkylamino side chain in addition to hydroxyalkoxyalkylamino.

Deguchi et al. teaches , as noted above, several diaminostilbene compounds for photographic imaging. See formula I on col. 2 and note the definition of L¹ and L² which includes aminoalkyl with two or more hydroxyl and sulfoalkylamino.

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Thus one having ordinary skill in the art at the time of the invention was made would have been motivated to combine both the primary and secondary references and employ the process taught by these prior art to the starting materials and reactants including those with aminoalkyl with two or more hydroxyl, hydroxyalkoxyalkylamino and sulfoalkylamino in view of the equivalency teaching and expect to obtain the desired product because he would have expected the analogous starting materials and reactants react similarly and yield product and have the same utility .

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB

V. Balasubramanian (Bala)

4/20/2001

Mukund J. Shah

MUKUND J. SHAH

SUPERVISORY PATENT EXAMINER

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